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Mitch Fredrick Singer

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PROCOPIO, CORY, HARGREAVES & SAVITCH LLP

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SUITE 2200

SAN DIEGO, CA 92101

EXAMINER

LANIER, BENJAMIN E

ART UNIT

PAPER NUMBER

2432

NOTIFICATION DATE

DELIVERY MODE

05/05/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|---------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/686,686 | Applicant(s) SINGER ET AL. | |
| | Examiner BENJAMIN E. LANIER | Art Unit 2432 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16-27, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-27, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 07 April 2010 amends claim 14. Applicant's amendment has been fully considered and entered.

Response to Arguments

2. Applicant argues, "Novak fails to teach or suggest both '...said version is bound to the hub network and stored on said server, and said sub-copy version is bound to members of said hub network.'" This argument is not persuasive because Novak discloses the licensed users are only able to access the content from devices connected to the network ([0100]). Therefore, the content is tied to the network, and users outside of the network are prevented from making copies of the content. Additionally, the source version of the content provided to the STB of licensed users is stored at the server of the content source on the network ([0099]).

3. Applicant argues, "Novak's accessing of content by just connecting to the network fails to teach or suggest that 'the source version [of the content] is bound to the hub network and stored on said server.'" This argument is not persuasive because Novak discloses that the source version of the content provided to the STB of licensed users is stored at the server of the content source on the network ([0099]).

4. Applicant argues, "Novak clearly discloses that 'the user 402 may store the digital content 404 on physical media such as CDs, DVDs...' The copying of the digital content on CDs and DVDs clearly allows the Novak device to remove the digital content from the 'network.'" This argument is not persuasive because the information required to actually playback the content is stored within the set-top box ([0100]) (i.e. decryption keys). Therefore, because the

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keys used to playback the content are stored on the set-top box, the content is tied to the set-top box.

5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the concept being "bound" to members of the hub network means that the content cannot be freely copied onto other media unless a compliant device first requests to unbind the sub-copy of the content from the network by changing the bound sub-copy to a discrete version before any sub-copy version of the content can be removed) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

6. Applicant argues, "Novak fails to teach or suggest 'receiving said sub-copy version from a device that is a member of a different hub network from said hub network...'. This argument is not persuasive because Novak discloses that the content is provided to the network from content providers through high-power satellites in geosynchronous orbit ([0054]-[0055]).

7. Applicant argues, "The Office Action fails to address claim 6. However, assuming the Examiner meant to use the similar reference to reject claim 6 as claim 5..." This argument is not persuasive claim 6 was rejected with claims 2, and 16-27 (See paragraph 9 of the previous Office Action which states "Claims 2, 6, 16-27 are rejected). Claim 6 is addressed with respect to claim 2. The unintentional omission of number 6 from the body was a typographical error.

8. Applicant argues, "Paragraph [0040] does not mention anything about an expiration time." This argument is not persuasive because paragraphs [0040] and [0108] discuss periods of validity, which would include an expiration time by definition. Specifically the cited paragraphs

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discuss the licenses having a valid time period after which the license may be revoked/disabled for a set time period.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 3-5, 7-14, 30-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Novak, U.S. Publication No. 2003/0097655. Referring to claims 1, 8, Novak discloses a client sending a license request to a server (Figure 4, 409), which meets the limitation of sending a license request from a client to a server, sending a connection confirmation from said client to said server, said connection confirmation indicates said client is connected to said server, sending a connection confirmation request from said server to said client, said connection confirmation request requests confirmation that said client is connected to said server. Subsequent to the request, the client receives the license (Figure 4, 411) and stores the license in memory (Figure 4, 306), which meets the limitation of receiving a sub-copy license at said client from said server in response to said license request. The licenses are also maintained by the source ([0120]), which meets the limitation of a copy of a source version stored on said server, the source version being a source for copies of content data in the hub network. The client and the server are connected over a hub network (Figure 1, 101), which meets the limitation of said client and said server are connected in a hub network and are members of said hub network. The

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license information allows the client to access specific content that was previously received and stored ([0099]), which meets the limitation of said license request identifies a sub-copy version of content stored on said client, said sub-copy version includes sub-copy locked content data, and said license data corresponding to said sub-copy version is bound to said hub network, said sub-copy version is a copy of a source version of content, the source version being a source for generating the sub-copy version of content which is provided to the client through the hug network when the client is connected to the server. Novak discloses the licensed users are only able to access the content from devices connected to the network ([0100]), which meets the limitation of wherein said source version is bound to the hub network and stored on said server, and said sub-copy version is bound to members of said hub network.

Referring to claim 3, Novak discloses that the license information can include sublicenses and is required to be re-verified after expiration ([0107 & 0119]), which meets the limitation of updating said sub-copy license for said sub-copy version stored on said client, wherein updating said sub-copy license includes updating said sub-copy license according to said received sub-copy license data, said license data corresponds to a sub-copy license for said sub-copy version and includes data for updating said sub-copy license.

Referring to claim 4, Novak discloses that the license information can include sublicenses for content ([0119]), which meets the limitation of said sub-copy license indicates permissions for using said sub-copy version.

Referring to claim 5, Novak discloses that the sublicenses have set periods of validity ([0040] & [0108]), which meets the limitation of said sub-copy license indicates an expiration period, and said expiration period indicates an amount of time for which said sub-copy license is

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valid, when said expiration time has been reached after sending said license data, said sub-copy license expires and becomes disabled.

Referring to claim 7, Novak discloses that the license request includes an identification of specific content ([0024]), which meets the limitation of said license request indicates said sub-copy version.

Referring to claim 9, Novak discloses that the client and server are connected within a local environment ([0052]), which meets the limitation of said connection confirmation indicates said client is within a local environment of said server, and said local environment is a limited area defined relative to said server.

Referring to claims 10-12, Novak discloses that once a license has expired on the client, a connection with the server is re-established to receive a new license and license key used to access the content ([0106]-[0107]), which meets the limitation of sending a security confirmation from said client to said server, wherein said security confirmation indicates a state of security data stored on said client, receiving a security confirmation at said server from said client, wherein said security confirmation indicates said state of said security data stored on said client, receiving a security update at said client from said server, wherein said security update includes new security data, said security data includes a new key for decryption.

Referring to claim 13, Novak discloses that a licensing term is defined that is longer than validity period of the individual licenses ([0106]). Therefore, subsequent licenses would have a validity term based off of the time remaining in the licensing term, which meets the limitation of setting an expiration time according to said received license data.

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Referring to claim 14, Novak discloses that the content is provided to the network from content providers through high-power satellites in geosynchronous orbit ([0054]-[0055]), which meets the limitation of receiving said sub-copy version from a device that is a member of a different hub network from said hub network. Subsequent to the request, the client receives the license (Figure 4, 411) and stores the license in memory (Figure 4, 306), which meets the limitation of obtaining a new license from a licensing authority indicated by the sub-copy version.

Referring to claims 30-31, Novak discloses a client sending a license request to a server (Figure 4, 409). Novak discloses that once a license has expired on the client, a connection with the server is re-established to receive a new license and license key used to access the content ([0106]-[0107]), which meets the limitation of sending/receiving a refresh request from a client to/at a server, sending a connection confirmation from said client to said server. Subsequent to the request, the client receives the license (Figure 4, 411) and stores the license in memory (Figure 4, 306), which meets the limitation of sending/receiving an updated sub-copy license at said client from said server in response to said refresh request. Novak discloses that the license information can include sublicenses and is required to be re-verified after expiration ([0107 & 0119]), which meets the limitation of updating a sub-copy license stored on said client according to said updated license data. The client and the server are connected over a hub network (Figure 1, 101), which meets the limitation of said client and server are members of a hub network. The license information allows the client to access specific content that was previously received and stored ([0099]), which meets the limitation of said refresh request corresponds to a sub-copy version of content stored on said client, said sub-copy version includes sub-copy locked content

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data, said sub-copy license is a license tied to said sub-copy version, said sub-copy version is bound to members of said hub network, and said sub-copy is generated from a source version that is bound to the hub network.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 2, 6, 16-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novak, U.S. Publication No. 2003/0097655, in view of Shamoon, U.S. Patent No. 7,233,948. Referring to claims 2, 6, Novak does not disclose synchronizing the client and server utilizing secure clocks. Shamoon discloses synchronizing the client and server utilizing secure clocks (Col. 33, line 60 – Col. 34, line 3), which meets the limitation of synchronizing a client clock with a server clock by setting said client clock according to said server clock before receiving license data including a sub-copy license at said client, wherein said client clock is a secure clock of said client, said server clock is a secure clock of said server. It would have been obvious to one of

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ordinary skill in the art at the time the invention was made for the client and server in Novak to be synchronized with secure clocks in order to correct timing in the event of a power loss, and/or check for tampering as taught by Shamoon (Col. 34, lines 2-3).

Referring to claim 16, 21, Novak discloses a client sending a license request to a server (Figure 4, 409), which meets the limitation of sending a license request from a client to a server, sending a connection confirmation from said client to said server, said connection confirmation indicates said client is connected to said server, sending a connection confirmation request from said server to said client, said connection confirmation request requests confirmation that said client is connected to said server. Subsequent to the request, the client receives the license (Figure 4, 411) and stores the license in memory (Figure 4, 306), which meets the limitation of receiving a sub-copy license at said client from said server in response to said license request. The licenses are also maintained by the source ([0120]), which meets the limitation of a copy of a source version stored on said server, the source version being a source for copies of content data in the hub network. The client and the server are connected over a hub network (Figure 1, 101), which meets the limitation of said client and said server are connected in a hub network and are members of said hub network. The license information allows the client to access specific content that was previously received and stored ([0099]), which meets the limitation of said license request identifies a sub-copy version of content stored on said client, said sub-copy version includes sub-copy locked content data, and said license data corresponding to said sub-copy version is bound to said hub network, said sub-copy version is a copy of a source version of content, the source version being a source for generating the sub-copy version of content which is provided to the client through the hug network when the client is connected to the server.

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Novak discloses the licensed users are only able to access the content from devices connected to the network ([0100]), which meets the limitation of wherein said source version is bound to the hub network and stored on said server, and said sub-copy version is bound to members of said hub network. Novak does not disclose synchronizing the client and server utilizing secure clocks. Shamooun discloses synchronizing the client and server utilizing secure clocks (Col. 33, line 60 – Col. 34, line 3), which meets the limitation of synchronizing a client clock with a server clock by setting said client clock according to said server clock before receiving license data including a sub-copy license at said client, wherein said client clock is a secure clock of said client, said server clock is a secure clock of said server. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the client and server in Novak to be synchronized with secure clocks in order to correct timing in the event of a power loss, and/or check for tampering as taught by Shamooun (Col. 34, lines 2-3).

Referring to claim 17, Novak discloses that the license information can include sublicenses and is required to be re-verified after expiration ([0107 & 0119]), which meets the limitation of said license data corresponds to a sub-copy license for said sub-copy version and includes data for updating said sub-copy license.

Referring to claim 18, Novak discloses that the license information can include sublicenses for content ([0119]), which meets the limitation of said sub-copy license indicates permissions for using said sub-copy version.

Referring to claim 19, Novak discloses that the sublicenses have set periods of validity ([0040] & [0108]), which meets the limitation of said sub-copy license indicates an expiration period, and said expiration period indicates an amount of time for which said sub-copy license is

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valid, when said expiration time has been reached after sending said license data, said sub-copy license expires and becomes disabled.

Referring to claim 20, Novak discloses that the license request includes an identification of specific content ([0024]), which meets the limitation of said license request indicates said sub-copy version.

Referring to claim 22, Novak discloses that the client and server are connected within a local environment ([0052]), which meets the limitation of said connection confirmation indicates said client is within a local environment of said server, and said local environment is a limited area defined relative to said server.

Referring to claims 23-26, Novak discloses that once a license has been received on the client, a connection with the server is re-established to receive a new license and license key used to access the content ([0106]-[0107]), which meets the limitation of sending a security confirmation from said client to said server, wherein said security confirmation indicates a state of security data stored on said client, receiving a security confirmation at said server from said client, wherein said security confirmation indicates said state of said security data stored on said client, receiving a security update at said client from said server, wherein said security update includes new security data, said security data includes a new key for decryption.

Referring to claim 27, Novak discloses that the server stores a revocation list that is used to check whether a license has been revoked ([0027]), which meets the limitation of checking a revocation list to determine whether said client is included in said revocation list, wherein said revocation list is stored on said server.

Conclusion

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14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN E. LANIER whose telephone number is (571)272-3805. The examiner can normally be reached on M-Th 7:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin E Lanier/
Primary Examiner, Art Unit 2432